

REMARKS

Applicants would like to thank Examiner C. N. Hawkins for allowing and conducting the interview of July 6, 2004. The substantive matters discussed in the interview are incorporated in the arguments set forth below.

In the last Office Action, the Examiner rejected claims 24 and 25 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter of the invention; rejected claims 1-4, 6, 7, 10, 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf (U.S. Patent No. 3,654,038) in view of Morel et al. (U.S. Patent No. 4,783,054); rejected claim 8 under 35 U.S.C. 103 as being unpatentable over Hottendorf ('038) and Morel ('054) as applied to claim 3 and further in view of Talalay (U.S. Patent No. 4,504,336) and DuFresne (U.S. Patent No. 2,931,751); rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf ('038). and Morel et al. ('054) as applied to claim 1 and further in view of Lindstrom et al. (U.S. Patent No. 4,321,103); rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf ('038) and Morel et al. ('054) as applied to claim 3 and further in view of Heuser et al. (U.S. Patent No. 3,698,296) and Hoover (U.S. Patent No. 2,325,400); rejected claims 12 through 14 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf ('038) and Morel et al. ('054) as applied to claim 1 and further in view of Miyajima et al. (U.S. Patent No. 6,321,813), Farfaglia et al. (U.S. Patent No. 3,847,540), Sbrana (U.S. Patent No. 5,972,151) and Heuser et al. ('296).

By this amendment, Applicants amend claims 1, 3, 6-8, 11-15, and 4, and cancel claims 9 and 25. Claims 1-4, 6-8, 10-24, and 26-27 are pending. Of these claims, claims 1-4, 6-8, 10-14, and 24 are presented for examination.

Applicants respectfully traverse the Examiner's rejection of claims 24 under 35 U.S.C. §112, second paragraph. However, in order to expedite prosecution of the present application, claim 24 has been amended to depend from one of claims 1-4, 6-8, and 10-14, and recite that "the segments of the sheet are suitably positioned by the device to maintain a gap between adjacent tiles," thereby rendering the Examiner's rejection moot. Accordingly, Applicants respectfully submit that claim 24 satisfies the requirements of 35 U.S.C. §112, second paragraph.

Applicants respectfully traverse the Examiner's rejection of claims 1-4, 6, 7, 10, 24 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf in view of Morel et al. Claim 1, for example, is not obvious over Hottendorf and Morel et al., because neither reference taken alone or in combination teaches or suggests each and every element of claim 1. In particular, the applied references at least fail to disclose the claimed combination including "a device for producing panels of mosaic tesserae having at least a supporting and/or lining sheet on a visible face of said tesserae arranged inside an advancing frame," "application means for applying said sheet over said mosaic tesserae," and "suction drum rotating means to retain at least temporarily, on an outer cylindrical surface thereof, said sheet segments, and to release said segments onto said mosaic tesserae."

Hottendorf teaches a "box taping machine" for taping and folding paperboard box blanks wherein a strip of tape is applied to one side edge of a box blank, but is silent as to a device for producing panels of mosaic tesserae arranged inside of a frame.

Hottendorf is also silent at least to the claimed suction drum "rotating means configured to be lowered ... such that ... said suction drum is lowered back when a next incoming

frame is in a suitable position ... corresponding to a location *a few millimeters* from the perimeter of said advancing frames” (emphasis added).

Morel et al. discloses a pneumatic device for fitting cables in a tube, but also does not teach the claimed combination including “a device for producing panels of mosaic tesserae having at least a supporting and/or lining sheet on a visible face of said tesserae arranged inside an advancing frame,” “application means for applying said sheet over said mosaic tesserae,” “suction drum rotating means to retain at least temporarily, on an outer cylindrical surface thereof, said sheet segments, and to release said segments onto said mosaic tesserae,” and “suction drum rotating means further equipped with an alternate lifting/lowering movement, such that after one of said segments of said sheet has been released, said suction drum is raised to allow the advancing frame to pass, and said suction drum is lowered back when a next incoming frame is in a suitable position to receive another one of said segments of said sheet,” moreover the Examiner does not rely on Morel et al. for such teachings.

Thus, Morel et al. fails to overcome the above described deficiencies of Hottendorf, and claim 1 is allowable over the Examiner’s proposed combination of references.

Applicant’s also note that Hottendorf would be incapable for use with a frame containing a plurality of mosaic tesserae as required by the present invention. Hottendorf is drawn to a machine that is configured to folding flaps of a paperboard to make a box. See Fig. 1 and col. 1, lines 45-63. The paperboard container 16 is subjected to forces that places portions, for example, the flaps 18 and 20 in substantially vertical and inverted positions. See Fig. 1. Such a process could not be used to produce panels having a plurality of mosaic tesserae because the tesserae

contained within the panels would become and dislodged and may even fall out if placed in a vertical or inverted position as taught by Hottendorf.

In addition, Hottendorf and Morel et al. constitute non-analogous art. Prior art references, in order to be properly applied, must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which Applicants were concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), and MPEP §2141.01(a). Hottendorf and Morel et al., however, relate to subject matter entirely unrelated to the subject matter recited in claim 1. Morel et al. is drawn to a pneumatic device for fitting cables in a tube, and Hottendorf relates to an "box taping machine," wherein the application discloses a machine for taping and folding paperboard box blanks. Neither reference relates whatsoever to a device for producing panels of mosaic tesserae as recited in claim 1. Accordingly, in view of the non-analogous teachings of both references, Applicants submit that one of ordinary skill in the art would not combine these references in order to obtain the combination recited in claim 1.

Further, Hottendorf would be rendered unsatisfactory for its intended purpose if modified with Morel et al. as proposed by the Examiner. See MPEP §2143.01. Hottendorf uses a baffle 107, mounted within taping wheel 82, to cut off suction in only the upper right quarter of the taping wheel 82. See col. 2, lines 55-65. Thus, suction is terminated in the area where the tape to be released is attached, and suction is maintained in other areas to facilitate holding of a subsequent piece of tape. On the other hand, Morel et al. teaches that a flexible tube 27 is clamped to completely stop the flow of compressed air. See col. 3, lines 30-35. If one of ordinary skill in the art were to utilize the teachings of Morel et al. to completely block the passage of compressed air in

pipe 86 in Hottendorf, Hottendorf's device would be rendered inoperable and unsatisfactory for its intended purpose. One of ordinary skill, therefore, would not modify Hottendorf in view of Morel et al. for this reason also. Therefore, Applicants respectfully submit that the clamping means of Morel et al. is not an art recognized equivalent of the baffle 107 described in Hottendorf.

Additionally, Applicants submit that the Examiner's conclusion of obviousness is based upon improper hindsight. One with ordinary skill in the mosaic tesserae art would not look towards the box taping or cable fitting art for knowledge. In light of the above-described deficiencies of both Hottendorf and Morel et al., Applicants submit that claim 1 is allowable over the applied references, and claims 2-4, 6, 7, 10, and 24 are allowable at least due to their dependence from claim 1.

Applicants respectfully traverse the rejection of claim 8 under 35 U.S.C. 103 as being unpatentable over Hottendorf and Morel et al. as applied to claim 3 and further in view of Talalay and DuFresne. Talalay and DuFresne fail to disclose a means to deliver steam or nebulized water arranged in cooperation with the visible face of said mosaic tesserae, said means to deliver being configured to deliver a jet against said face to reactivate the gluing means on said sheet. However, even if Talalay and DuFresne teach what the Examiner alleges (and Applicants disagree that they do), the references still fail to overcome the shortcomings of Hottendorf and Morel et al. discussed above. Therefore, claim 8 is allowable at least due to its dependence from claim 1.

Applicants respectfully traverse the rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over Hottendorf and Morel et al. as applied to claim 1 and further in view of Lindstrom et al.

Insofar as the Examiner's rejection of claim 9 is relevant to amended claim 1, Applicants note that Lindstrom et al. is directed toward a mechanism for applying merchandising labels to packages. The Examiner relies on Lindstrom et al. allegedly for teaching "means for alternately lifting and lowering the label applying roller in synchronism" (Office Action at page 6). Applicants respectfully disagree with the Examiner that such teachings, even if present in Lindstrom et al. are combinable with Hottendorf and Morel et al. in the matter set forth at page 6 of the Office Action. In any event, Lindstrom et al. also fails to teach "a device for producing panels of mosaic tesserae having at least a supporting and/or lining sheet on a visible face of said tesserae arranged inside an advancing frame," "application means for applying said sheet over said mosaic tesserae," "suction drum rotating means to retain at least temporarily, on an outer cylindrical surface thereof, said sheet segments, and to release said segments onto said mosaic tesserae." Lindstrom et al. also fails to teach "rotating means configured to be lowered ... such that ... said suction drum is lowered back when a next incoming frame is in a suitable position ... said suitable position corresponding to a location *a few millimeters* from the perimeter of said advancing frames" (emphasis added) as recited in claim 1. Accordingly, Lindstrom et al. also does not overcome the above-described deficiencies of Hottendorf and Morel et al.

Applicants respectfully traverse the rejection of claim 11 under 35 U.S.C. 103 as being unpatentable over Hottendorf and Morel et al. and further in view of Heuser et al. and Hoover; and the rejection of claims 12-14 as being unpatentable over Hottendorf and Morel et al. in view of Miyajima et al. etc. Each of Heuser, Hoover, Miyajima, etc. is silent as to the claimed "device for producing panels of mosaic tesserae having at least a supporting and/or lining sheet on a visible face of said tesserae arranged inside an

advancing frame,” “application means for applying said sheet over said mosaic tesserae,” “suction drum rotating means to retain at least temporarily, on an outer cylindrical surface thereof, said sheet segments, and to release said segments onto said mosaic tesserae,” and the “rotating means configured to be lowered ... such that ... said suction drum is lowered back when a next incoming frame is in a suitable position ... said suitable position corresponding to a location *a few millimeters* from the perimeter of said advancing frames” (emphasis added). Accordingly, Heuser, Hoover, and Miyajima et al. etc. also fail to remedy the shortcomings of Hottendorf and Morel et al. discussed above, and claims 11-14 are thus allowable at least due to their dependence from claim 1.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-4, 6-8, 10-14, and 24 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 3, 6-8, 11-15, 24 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Applicants respectfully submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants, therefore, request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

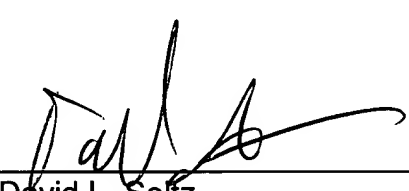
Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
David L. Soltz
Reg. No. 34,731